REMARKS

STATUS OF THE CLAIMS:

Applicant hereby withdraws claims 36-39, the subject matter of the claims of Group III and directed to a method for separating a plurality of analytes, from examination without prejudice.

Claim 1 has been amended to recite the limitations of claim 7, and claim 7 has been canceled accordingly. Claims 14 and 27 have been amended to correct dependencies. New claims 40 - 44 have been added to more particularly point out and distinctly claim that which Applicant regards as the invention. Support for new claim 40 can be found, *inter alia*, on page 4, line 21 through page 5 line 4. Support for new claim 41 can be found, *inter alia*, at page 6, lines 4-6. Support for the new claims 42-44 can be found, *inter alia*, in Applicant's specification on pages 19-20.

Accordingly, upon entry of this amendment, claims 1-6, 8-35 and 40-44 are pending. No new matter has been introduced by way of these amendments.

RESTRICTION REQUIREMENT:

In the Office Action, the Examiner required restriction between the following three groups of claims:

I. claims 1-24, directed to a composition, classified in class 210, subclass 198.2;

II. claims 25-35, directed to a method of modifying an inorganic substrate, classified in class 210, subclass 656; and.

III. claims 36-39, directed to a method of separating, classified in class 210, subclass 635.

The Examiner stated that the inventions are distinct from each other because of the following reasons:

Inventions I and II are related as process of making and product made. Citing the Manual of Patent Examining Procedure ("MPEP") § 806.05(f), the Examiner stated that the inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process. The Examiner alleged that the product as claimed can be

made by another and materially different process, for example it could be made by a reaction in a stirred chemical reactor.

Inventions I and III are related as product and process of use. Citing MPEP § 806.05(h), the Examiner stated that the inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. The Examiner alleged that the product as claimed can be used in a materially different process of using that product, for example it could be used as a catalyst of biocatalyst in a chemical or biochemical reaction process.

Inventions II and III are unrelated because they are directed to different methods with different purposes and different steps.

REQUIREMENTS TO ELECT SPECIES:

In addition to the restriction requirement, the Examiner has alleged that the application contains claims directed to patentably distinct species, and has required that Applicant elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claims is held to be allowable. The Examiner indicated that claims 1, 25 and 36 are considered to be generic.

The following species elections have been required.

Election 1: the Examiner alleges that each R^1, such as cyclodextrin, is a distinct species.

Election 2: the Examiner alleges that each R^2, such as cyclodextrin, is a distinct species.

Election 3: the Examiner alleges that each Q, such as cyclodextrin, is a distinct species.

Election 4: the Examiner alleges that each endcapping silane, such as trimethylchlorosilane, is a distinct species.

RESPONSE TO RESTRICTION AND SPECIES ELECTION REQUIREMENTS:

In response, Applicant elect Group I, claims 1-6 and 8-24 and new claims 40-44, with traverse. This election is made with traverse for the reasons set forth below. Applicant expressly reserves their right under 35 U.S.C. § 121 to file a divisional application directed to the nonelected subject matter during the pendency of this application.

The restriction requirement is traversed for the following reasons:

Section 806.05(i) of the Manual of Patent Examining Procedure (MPEP) states as follows: "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Applicant respectfully submits that examination of the claims of groups I and II can be made together without serious burden, as evidenced by the relatedness of the subject matter as method of producing a product and the product made.

In addition, the subject matter of the claims of groups I and II are linked by linking claim 23, directed to "[t]he composition of claim 9, wherein the silica gel is modified by the following steps: a) equilibrating the silica gel in an atmosphere having a defined relative humidity; b) modifying the silica gel with at least one silane; and c) further modifying the silica gel with an endcapping silane," and claim 40, directed to "[t]he composition of claim 1, wherein the inorganic substrate is modified by the following steps: a) equilibrating the inorganic substrate in an atmosphere having a defined relative humidity; b) modifying the inorganic substrate with at least one silane; and c) further modifying the inorganic substrate with an endcapping silane." In accordance with MPEP § 809, "**linking claims must be examined with the invention elected, and should any linking claim be allowed, the restriction requirement must be withdrawn.**" (Emphasis added).

In the event the Examiner is not persuaded to withdraw the restriction requirement, Applicant respectfully points out that MPEP § 809 further states:

> [a]ny claim(s) directed to the nonelected invention(s), previously withdrawn from consideration, which depends from or includes all the limitations of the allowable linking claim **must** be rejoined and will be fully examined for patentability. Where such withdrawn claims have been canceled by applicant in response to the restriction requirement, upon allowance of the linking claim(s), the examiner must notify applicant that any canceled, nonelected claim(s), which depends from or includes all the limitations of the allowable linking claim may be reinstated by submitting the claim(s) in an amendment. Upon entry of the amendment, the claims will be fully examined for patentability. (Emphasis added).

Accordingly, Applicant respectfully submits that restriction between claims of groups I and II is improper, and that the Examiner would in any event be required to examine the claims of groups I and II together in one application. Applicant therefore respectfully requests that the Examiner

withdraw the requirement for restriction as to the claims of groups I and II.

Applicant further respectfully submits that examination of the claims of groups II and III can be made together without serious burden, as evidenced by the relatedness of the subject matter, both being classified in Class 210. As these claims are in related art areas, no additional searching would be required and there would be no serious burden on the Examiner in examining these claims together.

Further, Applicant respectfully submits that examination of the claims of groups I and III can be made together without additional burden in view of the conclusions of the preceding arguments that would require that the claims of groups I and II be examined together and that the claims of groups II and III be examined together. Therefore, there would be no serious burden in examining all of the claims of the application together.

In summary, Applicant respectfully submits that since examination of linking claims 23 and 40 with the elected claims of group I would require the examination of the claims of group II along with the claims of group I, restriction between the these two groups of claims is improper. Further, there is no serious burden on the Examiner in examining the claims of groups II and III together, as they are in related art areas and would not require additional searching. Therefore, the restriction requirement is improper. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the restriction between the claims of groups I, II and III.

With respect to the requirement to elect species, Applicant makes the following elections:

Election 1: R^1 is defined as hydrogen, $C_1 - C_{100}$ substituted or unsubstituted hydrocarbyl, cycloalkyl, heterocycloalkyl, aryl, or heteroaryl; wherein the substituents are selected from $C_1 - C_{12}$ hydrocarbyl, hydroxyl, alkoxy, halogen, amino, nitro, sulfo, and carbonyl. Applicant elects $C_1 - C_{100}$ substituted or unsubstituted hydrocarbyl. Claims 1-6, 8-24, 26-29 and 40-41 read on this species. If further election is required, Applicant elects $C_{15}H_{31}$ as elected species.

Election 2: R^2 is defined as hydrogen, $C_1 - C_{100}$ substituted or unsubstituted hydrocarbyl, cycloalkyl, heterocycloalkyl, aryl, or heteroaryl; wherein the substituents are selected from $C_1 - C_{12}$ hydrocarbyl, hydroxyl, alkoxy, halogen, amino, nitro, sulfo, and carbonyl. Applicant elects $C_1 - C_{100}$ substituted or unsubstituted hydrocarbyl. Claims 1-6, 8-24, 26-29 and 40-44 read on this species. If further election is required, Applicant elects CH_3 as the elected species.

Election 3: Q is defined as from -NHC(O)-, -C(O)NH-, -OC(O)NH-, -NHC(O)O-, -

NHC(O)NH-, -NCO, -CHOHCHOH-, $-CH_2OCHCH_2O-$, $-(CH_2CH_2O)_n-$, $-(CH_2CH_2CH_2O)_n-$, -C(O)-, -C(O)O-, -OC(O)-, $CH_3C(O)CH_2-$, -S-, -SS-, -CHOH-, -O-, -SO-, $-SO_2-$, $-SO_3-$, $-OSO_3-$, $-SO_2NH-$, $-SO_2NMe-$, -NH-, -NMe-, $-NMe_2^+-$, $-N[(CH_2)_n]_2^+-$, -CN, -NC, -CHOCH-, -NHC(NH)NH-, $-NO_2$, -NO, $-OPO_3-$, where n is 1-30. Applicant respectfully points out that cyclodextrin is not a species included in Q. Applicant elects -C(O)NH-, denoting (carbamyl). Claims 1-6, 8-24, 26-29 and 40-42 read on this species.

Election 4: Endcapping silanes are defined as monosilanes, disilanes, trisilanes or tetrasilanes, or combinations thereof. Applicant elects monosilanes as the species of endcapping silane. Claims 9-15, 23-35 and 40 read on this species. If further election is required, Applicant elects trimethylchlorosilane as the species of endcapping silane.

Applicant respectfully reminds the Examiner that these elections of species are for the sole purpose of the Examiner's initial search and examination, and that upon allowance of a generic claim, applicants are entitled to have all non-elected species encompassed by that claim examined (37 C.F.R. § 1.141).

INFORMATION DISCLOSURE STATEMENTS:

In compliance with the provisions of 37 C.F.R. §§ 1.56, 1.97(b) and 1.97(e), Applicant herewith submits Information Disclosure Statements making of record the references cited in the International Search Report in the corresponding PCT application. A copy of the search report is included herewith. Additional references that may be pertinent to this application are also submitted in a Supplemental Information Disclosure Statement. The submission of an Information Disclosure Statement is not an admission that the information cited in the statement is, or is considered to be, prior art or material to patentability as defined in 37 C.F.R. § 1.56.

Applicant respectfully requests that the Examiner consider the cited references and make them of record in this application by initialing the appropriate boxes on the enclosed forms PTO Form-1449.

CONCLUSION

Entry of this Preliminary Amendment is respectfully requested. Applicant requests that the Examiner reconsider and withdraw the requirement for restriction between the inventions of the claims of Groups I, II and III.

If the Examiner has any questions concerning this communication, or would like to discuss the application, the art, or other pertinent matters, he is welcome to contact the undersigned attorney at (650) 565-8185.

Respectfully submitted,

By: _____

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